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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,920	04/12/2004	Karl Pays	05725.1347-00000	2432
Thomas L. Irving <sup>7590</sup> FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315				
EXAMINER				
VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1615				
MAIL DATE		DELIVERY MODE		
03/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/821,920

**Applicant(s)**

PAYS ET AL.

**Examiner**

JYOTHSNA A. VENKAT Ph. D

**Art Unit**

1615

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 5, 8-12, 16, 18, 19, 21-24, 26, 36, 40, 45, 71, 73, 77, 79, 82 and 83 is/are pending in the application.
- 4a) Of the above claim(s) 16, 71, 73, 77, 79, 82 and 83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 8-12, 18, 19, 21-24, 26, 36, 40 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/10/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Receipt is acknowledged of amendment, election and IDS filed on 12/10/07. Claims 3, 4, 6, 7, 13-15, 17, 20, 25, 27-35, 37-39, 41-44, 46-70, 72, 74-76, 78, 80 and 81 have been canceled as per applicants' amendment dated 12.10.07. Claims 1, 2, 5, 8-12, 16, 18, 19, 21-24, 26, 36, 40, 45, 71, 73, 77, 79, 82 and 83 are pending in the application and the status of the application is as follows:

#### *Election/Restrictions*

1. Applicant's election of group I in the reply filed on 12/10/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 71, 73, 77, 79, 82 and 83 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/10/07.
3. Applicant's election of species drawn to polystyaryl acrylate belonging to semi-crystalline polymer (at least one first compound) in the reply filed on 12/10/07 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/10/07.

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5. Claims 1, 2, 5, 8-12, 18-19, 21-24, 26, 36, 40, and 45 are pending in the application and the status of the application is as follows:

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 2, 5, 8-12, 18-19, 21-24, 26, 36, 40, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 3,911,105(105) and 5,866,111 ('111).

*Instant application is claiming a cosmetic composition comprising:*

*Polystearyl acrylate*

*Sulfoester as the film forming polymer in a cosmetically acceptable medium*

*Dyestuff (claim 36).*

Patent '105 teaches cosmetic make up compositions using polystearyl acrylate. This compound is the species of formula II. See the abstract, see col.1, ll 5-46, see col.2, ll 1-46, see col.3, ll 65-66, see col.4, ll 49-65 for dyestuff, see col.4 last paragraph for solvents. These solvents belong to cosmetically acceptable medium. See also col.5, ll 9-64 for various cosmetic products. See examples and see claims 1-12 and see especially claim 5 for polystearyl acrylate. Patent '105 does not teach the film forming polymer sulfoester. However, patent '111 teaches claimed sulfoester as the film forming 'polymer and using this film former in cosmetic compositions. See the abstract, see col.3, line 37 through col.4 line 43. See col.4, line 25 for EASTMAN AQ polymers. Sulfoester is also EASTMAN AQ polymer. See col.5, ll 19-26 and see the examples. Both the compositions taught by patent are drawn to mascara compositions (cosmetic).

Accordingly it would be obvious to one skilled in the cosmetic art to prepare a third composition by combining the prior art ingredients. One of ordinary skill in the cosmetic art would combine the polystearyl acrylate and dyestuff of patent '105 and combine it with the film forming polymer since the third composition which has polystearyl acrylate when used in the form of mascara has good adherence and have sufficient brilliance and when polystearyl acrylate is combined with film forming polymer of patent '111, the composition in the form of mascara has the properties of eyelash elongation, eyelash curving which are beneficial to the consumer. Combining the prior art ingredients in the field of endeavor prompt variations of it for use in the same field of endeavor. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is

571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/JYOTHSNA A. VENKAT Ph. D/  
Primary Examiner, Art Unit 1615**